

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of
Eric THELEN, et al.

Atty. Docket
DE 030365US1

Confirmation No. 1808

Serial No. 10/576,165

Group Art Unit: 2425

Filed: APRIL 19, 2006

Examiner: CHOKSHI, Pinkal R.

Title: RECORDING CONTENT ON A RECORD MEDIUM THAT CONTAINS A
DESIRED CONTENT DESCRIPTOR

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APPEAL BRIEF

Sir:

Appellants herewith respectfully present a Brief on Appeal as follows, where a
Notice of Appeal is concurrently filed, having filed paid a fee for a Notice of Appeal on
September 21, 2009:

REAL PARTY IN INTEREST

The real party in interest in this appeal is the assignee of record Koninklijke Philips Electronics N.V., a corporation of The Netherlands having an office and a place of business at Groenewoudseweg 1, Eindhoven, Netherlands 5621 BA.

RELATED APPEALS AND INTERFERENCES

Appellants and the undersigned attorney are not aware of any other appeals or interferences which will directly affect or be directly affected by or having a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 1, 4-18 and 23-24 are pending in this application where claims 2-3 and 19-22 are canceled. Claims 1, 4-18 and 23-24 are rejected in the Final Office Action mailed in July 20, 2010. Claims 1, 4-18 and 23-24 are the subject of this appeal.

STATUS OF AMENDMENTS

Appellants did not file a Response to a Final Office Action mailed July 20, 2010. This Appeal Brief is in response to the Final Office Action mailed July 20, 2010, that finally rejected claims 1, 4-18 and 23-24.

SUMMARY OF THE CLAIMED SUBJECT MATTER

The present invention, for example, as recited in independent claim 1, shown in FIG 1 and described on page 10, lines 11-28, and page 11, lines 16-26 of the specification, is directed to a method for recording content 10 on a record medium 2 that contains a desired content descriptor 3, comprising storing the desired content descriptor on the record medium 2 by a first device, such as a device used by the record medium manufacturer or a sub-contractor, as described on page 4, line 29 to page 5, line 12. The method further includes reading the desired content descriptor 3 from the record medium 2 by a second device local to a user of the record medium 2, such as by the recording device 1 shown in FIG 1, where the first device is remote from the local device 1, and where the first device is associated with a provider of the record medium 2 and is different from the second device 1. The method further includes scanning by the second device 1 the content 10 of at least one multimedia source 6, 7 for desired content that matches the desired content descriptor 3; and recording the desired content on the record medium 2. As described on page 12, lines 11-19, the method further includes recording by the second/local device 1 the desired content on the record medium 2, where inserting the record medium 2 containing the desired content descriptor 3 into the local or second recording device 1 triggers the local recording device 1 to automatically perform the acts of scanning and recording.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1, 5-9, 11-18 and 23-24 of U.S. Patent Application Serial No. 10/576,165 are unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 5,526,130 (Kim) in view of U.S. Patent Application Publication No. 2005/0120373 (Thomas) and U.S. Patent No. 6,925,650 (Arsenault).

Whether claim 4 of U.S. Patent Application Serial No. 10/576,165 are unpatentable under 35 U.S.C. §103(a) over Kim in view of Thomas, Arsenault and U.S. Patent Application Publication No. 2002/0174430 (Ellis-430).

Whether claim 6 of U.S. Patent Application Serial No. 10/576,165 are unpatentable under 35 U.S.C. §103(a) over Kim in view of Thomas, Arsenault and U.S. Patent No. 7,171,174 (Ellis-174).

Whether claim 10 of U.S. Patent Application Serial No. 10/576,165 are unpatentable under 35 U.S.C. §103(a) over Kim in view of Thomas, Arsenault and U.S. Patent Application Publication No. 2006/0072354 (Ohnuma).

ARGUMENT

Claims 1, 5-9, 11-18 and 23-24 are said to be unpatentable under 35 U.S.C. §103(a) over Kim in view of Thomas and Arsenault.

Appellants respectfully request the Board to address the patentability of independent claim 1, and further claims 4-18 and 23-24 as depending from claim 1, based on the requirements of independent claim 1. This position is provided for the specific and stated purpose of simplifying the current issues on appeal. However, Appellants herein specifically reserve the right to argue and address the patentability of claims 4-18 and 23-24 at a later date should the separately patentable subject matter of claims 4-18 and 23-24 later become an issue. Accordingly, this limitation of the subject matter presented for appeal herein, specifically limited to discussions of the patentability of claim 1 is not intended as a waiver of Appellants' right to argue the patentability of the further claims and claim elements at that later time.

As correctly noted on page 4, paragraph two of the Final Office Action, Kim does not disclose or suggest "storing said desired content descriptor on said record medium by a first device; reading said desired content descriptor from said record medium by a second device local to a user of the record medium, wherein the first device is remote from the local device, and wherein the first device is associated with a provider of the record medium and is different from the second device," as recited in independent claim 1. Thomas is cited in an attempt to partially remedy the deficiencies in Kim.

Thomas is directed to methods and systems for extracting digital content using an interactive television application. As specifically recited in paragraph [0023]:

The interactive television application may store a reference to the selected digital content and the selected settings for transferring the selected digital content to removable media. In some embodiments, the reference to the selected digital content and the selected settings for transferring the selected digital content may be stored in a database. In some embodiments, the reference to the selected digital content and the selected settings for transferring the selected digital content may be stored on a configuration file stored on removable media. (Emphasis added)

Similarly, paragraph [0177] of Thomas recites:

In some embodiments, the reference to the selected digital content and the selected settings for transferring the selected digital content may be stored on a configuration file stored on a removable medium (e.g., removable medium 62). In some embodiments, the interactive television application may create and transfer the configuration file to the removable medium. (Emphasis added)

Further, paragraph [0188] of Thomas recites:

At step 1030, the interactive television application may transfer the referenced digital content to removable medium 62 in accordance with the settings for removable medium 62. The transfer may occur without requiring further user interaction.

Thus, in Thomas, the very same interactive television application stores both the reference to the selected digital content and the referenced digital content to removable medium 62.

This is acknowledged in the Final Office Action, where it is correctly noted on page 5, first full paragraph of the Final Office Action, that Kim and Thomas do not disclose or suggest "the first device is associated with a provider of the record medium and is different

from the second device," as recited in independent claim 1. Arsenault is cited in an attempt to partially remedy the deficiencies in Kim and Thomas.

As shown in FIG 4, and described in the Abstract, and column 18, lines 15-18, Arsenault is directed to a method and apparatus for transmitting, receiving and displaying electronic program guide data having a number of segments associated with programs, where some of the segments have a keyword. A receiver 132 (FIG 4) has a memory 148 that stores a keyword list containing keywords. The receiver 132 receives the program guide data and compares the segments of the program guide data to the keyword list stored in the memory 148 to determine if any keywords are contained in the segments. As recited on column 18, lines 15-18, the keywords are stored in the memory 148 of the receiver 132 by the receiver manufacturer. As clearly shown in FIG 4, the memory 148 that stores a keyword list is an internal/integrated memory of the receiver 132 and is NOT an insertable record medium. Further, the very same device, namely the receiver 32

Thus, even if different devices store and read any keywords in Thomas, there is no disclosure or suggestion in Thomas to record the keyword list on an insertable record medium, "wherein inserting the record medium containing the desired content descriptor into the second device triggers the second device to automatically perform the acts of scanning and recording," as recited in independent claim 1.

At best, the combination of Kim, Thomas and Arsenault discloses recording configuration file and content on a removable media by the very same device as disclosed in Thomas, where a manufacturer records a keyword list on an internal/integrated

memory 148 of Arsenault, where the internal/integrated memory 148 is NOT an insertable record medium.

Thus, the combination of Kim, Thomas and Arsenault does not disclose or suggest the present invention as recited in independent claim 1 which, amongst other patentable elements recites (illustrative emphasis provided):

storing said desired content descriptor on said record medium by a first device;

reading said desired content descriptor from said record medium by a second device local to a user of the record medium, wherein the first device is remote from the local device, and wherein the first device is associated with a provider of the record medium and is different from the second device;

scanning by the second device the content of at least one multimedia source for desired content that matches said desired content descriptor; and

recording by the second device said desired content on said record medium, wherein inserting the record medium containing the desired content descriptor into the second device triggers the second device to automatically perform the acts of scanning and recording.

Recording, by a second device, a desired content on the very same insertable medium that includes a desired content descriptor stored by a first device which is different from the second device, where the recording is automatically performed when this vary same record medium is inserted into the second device, is nowhere disclosed or suggested in Kim, Thomas, Arsenault, and combinations thereof.

Accordingly, it is respectfully requested that independent claim 1 be allowed. In addition, it is respectfully submitted that claims 5-9, 11-18 and 23-24 should also be allowed at least based on their dependence from independent claim 1 as well as their

individually patentable elements.

Claim 4 is said to be unpatentable under 35 U.S.C. §103(a) over Kim in view of Thomas and Arsenault and Ellis-430.

It is respectfully submitted that claim 4 should be allowed at least based on its dependence from independent claim 1.

Claim 6 is said to be unpatentable under 35 U.S.C. §103(a) over Kim in view of Thomas and Arsenault and Ellis-174.

It is respectfully submitted that claim 6 should be allowed at least based on its dependence from independent claim 1.

Claim 10 is said to be unpatentable under 35 U.S.C. §103(a) over Kim in view of Thomas and Arsenault and Ohnuma.

It is respectfully submitted that claim 10 should be allowed at least based on its dependence from independent claim 1.

In addition, Appellants deny any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. Any rejections and/or points of argument not addressed would appear to be moot in view of the presented remarks. However, the Appellants reserve the right to submit further arguments in support of the above stated position, should that become necessary. No arguments are waived and none of the Examiner's statements are conceded.

CONCLUSION

Claims 1, 4-18 and 23-24 are patentable over Kim, Thomas, Arsenault, Ellis-174, Ellis-430 and Ohnuma.

Thus, the Examiner's rejections of claims 1, 4-18 and 23-24 should be reversed.

Respectfully submitted,

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CLAIMS APPENDIX

1.(Previously Presented) A method for recording content on a record medium that contains a desired content descriptor of the content, the method comprising the acts of:

storing said desired content descriptor on said record medium by a first device;

reading said desired content descriptor from said record medium by a second device local to a user of the record medium, wherein the first device is remote from the local device, and wherein the first device is associated with a provider of the record medium and is different from the second device;

scanning by the second device the content of at least one multimedia source for desired content that matches said desired content descriptor; and

recording by the second device said desired content on said record medium, wherein inserting the record medium containing the desired content descriptor into the second device triggers the second device to automatically perform the acts of scanning and recording.

Claims 2-3 (Canceled)

4.(Previously Presented) The method according to claim 1, wherein said desired content descriptor contained in said record medium cannot be further altered or

augmented.

5.(Previously Presented) The method according to claim 1, wherein said desired content descriptor contained in said record medium can be further altered and augmented.

6.(Previously Presented) The method according to claim 1, wherein said desired content descriptor can be transferred from said record medium to a record medium of the same type or to a record medium of a different type.

7.(Previously Presented) The method according to claim 1, wherein said record medium is suited for electric and/or magnetic and/or optic recording of content.

8.(Previously Presented) The method according to claim 1, wherein said desired content descriptor is a keyword or a list of keywords.

9.(Previously Presented) The method according to claim 1, wherein said desired content descriptor obeys a pre-defined content description format.

10.(Previously Presented) The method according to claim 1, wherein said desired content descriptor comprises multimedia samples.

11.(Previously Presented) The method according to claim 1, wherein said desired content descriptor is a pre-defined content descriptor.

12.(Previously Presented) The method according to claim 1, wherein said desired content descriptor is defined by the user of said method.

13.(Previously Presented) The method according to claim 1, wherein said content from at least one multimedia source comprises image and/or audio and/or text information.

14.(Previously Presented) The method according to claim 1, wherein said at least one multimedia source is a receiver for television and/or radio programs.

15.(Previously Presented) The method according to claim 1, wherein said at least one multimedia source is a device that is connected to a computer network, in particular to the internet.

16.(Previously Presented) The method according to claim 13, wherein said act of scanning the content of said at least one multimedia source for said desired content comprises image and/or audio and/or word processing.

17.(Previously Presented) The method according to claim 1, wherein said act of

scanning the content of said at least one multimedia source for said desired content is performed dynamically depending on the available amount of content and/or on the already recorded content.

18.(Previously Presented) A machine-readable medium embodying a computer program, the computer program when executed by a processor is configured to perform the acts of claim 1.

Claims 19-22 (Canceled)

23.(Previously Presented) The method of claim 1, wherein the provider comprises a manufacturer of the record medium.

24.(Previously Presented) The method of claim 1, wherein the desired content descriptor is already contained in a blank of the record medium before the user has recorded any information on the record medium.

EVIDENCE APPENDIX

None

RELATED PROCEEDINGS APPENDIX

None